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Edwin W O'Brien

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWIN W. O'BRIEN, ANDY YIASOUMI,
DAVID C. RICHARDSON, and NATHALIE PLOUZENNEC

Appeal 2008-1385
Application 10/501,867
Technology Center 2800

Decided: August 27, 2008

Before BRADLEY R. GARRIS, CHUNG K. PAK, and
PETER F. KRATZ, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-7 and 9. We have jurisdiction pursuant to 35 U.S.C. § 6.¹

¹ Oral arguments were presented on August 14, 2008.

Appellants' claimed invention is directed to a light cover including a reflective element angled with respect to the cover. Claims 1 and 9 are illustrative and reproduced below:

1. A light cover arranged to be placed over a light source emitting infrared radiation, wherein said light cover comprises an aircraft exterior light cover, wherein the light cover includes a reflective element angled with respect to said light cover for reflecting a portion of said emitted infrared radiation away from said light cover and substantially away from said light source.

9. A light assembly comprising:
a light source mounted within a housing, the light source emitting infrared radiation;
a light cover placed over said light source; and
a reflective element located between said light source and said light cover and angled with respect to said light cover, said reflective element for reflecting a portion of the emitted infrared radiation away from the light cover and substantially away from said light source.

The Examiner relies on the following prior art reference as evidence in rejecting the appealed claims:

Gagnon	3,650,808	Mar. 21, 1972
Gray	3,984,673	Oct. 5, 1976
Carlson	4,495,549	Jan. 22, 1985
Bamber	5,017,327	May 21, 1991

Claim 9 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Gray. Claims 1-3 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gray in view of Carlson. Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gray in view of Carlson and Bamber. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gray in view of Carlson and Gagnon.

We affirm the anticipation rejection. We reverse all of the obviousness rejections. Our reasoning follows.

Rejection under § 102(b)

“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *accord Glaxo, Inc. v. Novopharm, Ltd.*, 52 F.3d 1043, 1047 (Fed. Cir. 1995). However, anticipation by a prior art reference does not require that the reference recognize the inventive concept of the claimed subject matter. *See Verdegall Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987).

Anticipation under this section is a factual determination. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 390 (Fed. Cir. 1991)(citing *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990).

Arguments not made in the Briefs are considered to be waived. *See* 37 C.F.R. § 41.37(c)(vii) (2006).

The Examiner has found that Gray anticipates subject matter embraced by claim 9; hence, the so stated rejection (Ans. 3-4).

Appellants do not contest the Examiner’s determination that Gray discloses a light source (16, Fig. 1) and an infrared ray (IR) reflective element (18, Fig. 1), each as parts of a light assembly. Rather, Appellants contend that Gray does not disclose the recited “light cover” feature, which, according to Appellants, must be transparent to visible light (App. Br. 11-12; Reply Br. 5-7). This argued transparency property is alleged to be missing from any light covering in Gray, such as element (10, Fig. 1) of Gray. *Id.* In subordinate contentions, Appellants urge Gray does not disclose the claim 9

requirement for specified interrelationships between the light source and light cover and between the reflector and light cover because Gray lacks the argued prerequisite transparent “light cover.” *Id.*

The principal issue developed by these contentions, as presented in Appellants’ Briefs, is: Have Appellants identified reversible error in the Examiner’s anticipation determination based on their assertion that the “light cover” called for as part of the assembly of claim 9 is transparent to light, a property that the light cover structure of Gray allegedly does not possess? We answer this question in the negative and we affirm the Examiner’s anticipation rejection.

As correctly determined by the Examiner, the light assembly of claim 9 does not require the light cover to be transparent to visible light (Ans. 9).

In this regard, Appellants assert the subject Specification allegedly provides a definition for the term “light cover” and further uses this terminology in a way that makes clear that nothing other than a transparent light cover is encompassed by the phrase “light cover” (App. Br. 11; Reply Br. 5-7). However, we find no clear definition for this claim term at the referred to portions of the Specification that require this argued narrow construction of “light cover”; that is, a construction necessarily requiring a visible light transparency property for the cover without explicitly specifying such a property in the claim itself, as a limitation. The argued Specification passage provides a description of an embodiment of the invention that is said to be “by way of example only” (Spec. 3: 4-5). The argued passage states:

Figure 1 shows a perspective view of a light cover according to an embodiment of the present invention. The cover comprises a transparent element 2 that is substantially the size and shape of the required light cover.

Spec. 3: 10-12 (App. Br. 11; Reply Br. 6)

A definition of the contested claim language that requires importation of a limitation from the Specification into the claims is not provided by the exemplary embodiment of Appellants' claimed invention furnished in the Specification. The Specification itself disavows such an importation by expressly discounting the described embodiment as a "by way of example only" embodiment. While the use of transparent light covers may be relatively common in the transportation industry, such as in the aircraft industry for exterior lighting provided by landing lights and navigation lights (Spec. 1), appealed claim 9 is not limited to an aircraft light assembly by the express language thereof. Appellants acknowledge as much (App. Br. 11). In interpreting claim terms, it is inappropriate to read in limitations from the Specification. *In re Paulsen*, 30 F.3d 1477, 1480 (Fed. Cir. 1994).

After all, during prosecution of a patent application, the claims therein are given the broadest reasonable interpretation consistent with the Specification as they would be understood by one of ordinary skill in the art to embrace. *Gechter v. Davidson*, 116 F.3d 1454, 1457, 1460 n.3 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989). As pointed out by the court in *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997):

Absent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation.

In addition, even if we could agree that Appellants had furnished a persuasive and substantiated argument establishing that claim 9 requires a transparent "light cover," Appellants have not fully explained in their Briefs

how our acceptance of such a claim construction would necessarily obviate Gray as an anticipatory reference. For example, Gray discloses that the assembled apparatus includes a view port (13), which “cover” element would provide for light transmission, with a reflective element (18) located between light source (16) and the view port light covering element (13). Appellants have not addressed this aspect of Gray’s assembly in asserting their claim construction argument in the Briefs.

For the reasons stated above, Appellants’ contention and principal argument asserting the unclaimed requirement for a transparent characteristic for the light cover of claim 9, which unclaimed feature is alleged to provide a patentable distinction over the structure of Gray, is unpersuasive. Thus, Appellants have not established reversible error in the Examiner’s anticipation rejection. It follows that we affirm the Examiner’s anticipation rejection of claim 9, on this record.

Rejections under § 103(a)

Independent claim 1 and dependent claims 2-7 require an aircraft exterior light cover including an angled IR reflective element.

Concerning the first stated obviousness rejection of claims 1-3 and 7, the Examiner acknowledges that Gray, which is directed to an external lighting system for hypobaric or hyperbaric chambers, does not teach or suggest an aircraft exterior light cover (Ans. 4; Gray, col. 2, ll. 16-20).

The Examiner turns to Carlson for a teaching with respect to aircraft exterior lights and an infrared radiation filter lens cover, which cover avoids detection by conventional weapons systems via the removal of IR using a fluid filter medium. (Ans. 4; Carlson, col. 1, ll. 20-30, col. 4, ll. 23-29, and col. 6, ll. 4-10).

Based on the combined teachings of Gray and Carlson, the Examiner contends that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the light cover of Gray comprising an aircraft exterior light cover so as to divert the infrared radiation away from the light source so as to avoid detection by conventional weapon systems as taught by Carlson” (Ans. 4-5).

Appellants contend that Gray “teaches a lighting system for a hyperbaric chamber,” not an aircraft exterior light system with covers therefore (App. Br. 6). While Appellants acknowledge that Carlson is directed to aircraft exterior lights, Appellants assert that Gray is not so directed and the Examiner’s proposed combination of these disparate references has no support (App. Br. 6: Reply Br. 1-5).

The question in this obviousness rejection is: Have Appellants identified reversible error in the Examiner’s assertion that one of ordinary skill in the art would have modified Gray’s lighting system based on the teachings of Carlson to arrive at the claimed subject matter? We answer this question in the affirmative and we reverse the Examiner’s obviousness rejection.

The Examiner bears the initial burden, on review of prior art or on any other ground, of presenting a prima facie case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Here, as correctly pointed out by Appellants (Br. 6-9), the Examiner has not fairly articulated why one of ordinary skill in the art would have turned to the aircraft lighting and protective system of Carlson for a suggestion as to how to modify the hyperbaric chamber lighting system of Gray in a fashion that would have led an ordinarily skilled artisan to Appellants’ claimed subject matter. Nor has

the Examiner reasonably explained why one of ordinary skill in the art would have turned to the disparate lighting arrangement of Gray to modify Carlson's aircraft light and radiation filter arrangement, which latter arrangement was designed to suppress IR emission from landing lights using a fluid filtration medium as a weapons defense from heat seeking missiles, as the Examiner notes (Ans. 7).

In making the assertions set forth in the Answer, the Examiner has seemingly taken at least some of the applied references' disclosures out of context without providing persuasive reasoning to support the contention that the combination thereof would have led one of ordinary skill in the art to the here-claimed subject matter.

Rejections based on § 103(a) must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). In other words, the Examiner's basis for the rejection falls short of identifying a rationale that would have led an ordinarily skilled artisan to combine selected features from each reference in a way that would have resulted in a product corresponding to the claimed light cover arrangement. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007).

On this record, we are constrained to reverse the stated obviousness rejection.

The Examiner's separate obviousness rejections, as they pertain to dependent claims 4-6, incorporate the above-discussed combination of Gray and Carlson. Because the additionally presented Bamber or Gagnon references are not cited to address this carryover deficiency from the

aforementioned rejection, we reverse the rejections as presented for dependent claims 4-6 for essentially the same reasons.

ORDER

The decision of the Examiner to reject claims 9 under 35 U.S.C. § 102(b) as being anticipated by Gray is affirmed. The decision of the Examiner to reject claims 1-3 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Gray in view of Carlson; to reject claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Gray in view of Carlson and Bamber; and to reject claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Gray in view of Carlson and Gagnon is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED-IN-PART

tf/ljs

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